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EXAMINER

POON, KING Y

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/897,647

Applicant(s)

BERKEMA ET AL.

Examiner

King Y. Poon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-21 and 23-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-21 and 23-35 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                               |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                                              | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/1/2005</u> . | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 7 is objected to because of the following informalities: "content provider" appears to be missing from claim 7 line 2. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Eldridge (EP 0893760).

Regarding claim 1, Eldridge et al. teach a method for serving a print by reference operation to print referenced content from a referenced location of a content provider to a print device (fig 4 & column 11, line 52 - column 12, line 7 a method for context-based transactions with tokens, i.e. references, between a portable device and a network), the method comprising steps of: accepting (fig 4, step s8", accepting a token, i.e. accepting a reference) from a print client (fig 1, PDA 2), a reference to print content targeted for printing from a content provider location indicated by the reference (column 9:line 44 - column 10, line 2, & column 8, lines 6-7, token/reference contains a URL for retrieval of a document located at address of URL); resolving the reference to determine the location indicated by the reference (fig 4, step s15 and column 12, lines 54-58,

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token/reference is decoded to determine URL), obtaining print data from the location indicated by the reference (fig. 4, step s16, document data is retrieved using URL provided by token/reference); transcoding the print data into a print device ready format (fig 4, step s18, print data is converted to a format that matches printer capability); allowing access to print data transcoded by said step of transcoding (fig 4, step s19, access to converted print data is allowed because it has been sent to the printer); transferring, in response to a request from the print client, print data transcoded by said step of transcoding (fig 4, step s19, print data is transferred, which is a result of the initial request from PDA 2 to the network).

Regarding claim 2, Eldridge et al. teach the method according to claim 1, wherein said step of accepting accepts the reference from an Internet connection to the print client (column 8; lines 2-5, a referenced document is processed by way of the internet).

Regarding claim 3, Eldridge et al. teach the method according to claim 1, wherein the reference comprises a universal resource locator address that addresses print content targeted for printing (column 8, lines 57-58, document identifier comprises a URL).

Regarding claim 4, Eldridge et al. teach the method according to claim 1, wherein said step of accepting accepts a reference list of individual references that each reference print content stored at a content provider location (column 3, line 53 - column 4, line 2 recites a method of decoding a token with multiple references to documents stored at other locations, column 8, lines 6-7, referenced by a URL).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al (EP 0893760).

Regarding claim 5, Eldridge et al. teach the method according to claim 4, wherein said steps of resolving, obtaining, transcoding, and allowing are completed for individual references, but do not explicitly teach wherein said steps of resolving, obtaining, transcoding, and allowing are completed for a first one of said individual references in said reference list before being conducted for another one of said individual references in said reference list.

However, serial and parallel processing are well-known in the art, therefore an inventor skilled in the art would combine the token with multiple references taught by Eldridge et al. with serial processing because it allows the retrieval of multiple documents to be accomplished.

6. Claims 7, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al (EP 0893760) in view of Petteruti et al (US 6,379,058), W3C SOAP 1.1 and Gase (US 6,184,996).

Regarding claims 7 & 8, Eldridge et al. teach the method according to claim 1 (please see discussion of claim 1), wherein the print client initiates control communication (5g 5, step s2), but does not teach the method further comprising a step (emphasis added) of initiating a control communication with the print client.

However, Petteruti et al. teach a step of initiating a control communication with the print client (column 6:lines 24-25).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the control communication initiated with the print client as taught by Petteruti et al. in the method of Eldridge et al. because it provides a method for additional functionality wherein the portable device is not the only device that initiates control communication.

Eldridge et al. & Petteruti et al. also does not teach wherein said step of initiating a control communication is conducted via the Simple Object Access Protocol, an argument resolution protocol, and said steps of accepting and transferring are conducted via the HUP protocol, a data transfer protocol.

However, W3C teaches the Simple Object Access Protocol (SOAP) (page 5, section 2, W3C teaches using SOAP for transmissions between a sender and a receiver, in this case a control communication initiator and the print client).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the SOAP taught by W3C to initiate control communication in the method taught by Eldridge et al. & Petteruti et al. because (W3C, page 26, section 6,

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SOAP can be binded to HTTP, providing the advantage of being able to use the formalism and decentralized flexibility of SOAP with the rich feature set of HTTP.

Additionally Gase teaches a HTTP protocol used for data transfer in a print-by-reference system similar to that taught by Eldridge et al. (column I, lines 26-35).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the HTTP protocol taught by Gase in the method taught by Eldridge et al., Petteruti et al. & W3C, because it allows for data transfer over the World Wide Web (Gase, column 11, lines 27-29), and it would compliment the use of the SOAP.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760) & Holtzman et al. (US 6,400,272).

Regarding claim 9, Eldridge et al. teach the method according to claim 1 , but do not teach the method further comprising steps of: accepting a security challenge from the location indicated by the reference; and responding to the security challenge.

However, Holtzman et al. teach a security challenge method for accessing requested information over a network connection, wherein, column 13, lines 30-31, a security challenge from the location indicated by the referenced information is accepted by the client, and responding to the security challenge involves prompting the resolve of the PIN request to the user.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the secure access method taught by Holzman et al. in the

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document/information retrieval system taught by Eldridge et al. because it would provide authentication access for secure document access in the Eldridge et al system.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760) & Holtzman et al. (US 6 400 272) as applied to claim 9 above, and further In view of Hull (US 6 772 338).

Regarding claim 10, Eldridge et al. & Holtzman et al. teach the method according to claim 9.

Additionally, Holtzman et al. teach the concept of passing the security challenge (i.e. PIN request mentioned above in claim 9 rejection) to the request, but Eldridge et al. do not teach wherein said step of responding comprises passing the security challenge on to the print client.

However, Hull teaches a method (fig 2) wherein information is passed from an office appliance 201 (i.e. the workstation 50 taught by Eldridge et al.) to a shuttle memory service 202 (i.e. PDA 2 taught by Eldridge et al.).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the method of information transfer taught by Hull in the method for secure document retrieval taught by Eldridge et al. & Holtzman et al. because it would provide a method to forward the PIN request taught by Holtzman et al. to the user of the PDA taught by Eldridge et al.

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9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760) & Iwata (US 6 778 289) & Hull (US 6 772 338).

Regarding claim 11: Eldridge et al. teach the method according to claim 1, but do not teach wherein said step of allowing comprises: establishing a universal resource locator address for the print data transcoded by said step of transcoding; and communicating the universal resource locator address for the print data to the print client.

However, Iwata teaches establishing a universal resource locator address for the print data that the server system manages, and communicating the universal resource locator address for the print data to a print client (column 5, lines 50-56, server defines URL for documents it manages and sends it to a print client).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the Iwata method for defining a URL of each document managed by a print server in the method for document retrieval taught by Eldridge et al. because it would define a URL for the transcoded document that the server system manages, allowing for other devices, i.e. print clients, to access the document using the URL.

Furthermore, Eldridge et al. do not teach said step of sending the URL to the print client.

However, Hull teaches a method (fig 2) wherein information is passed from an office appliance 201 (i.e. the workstation 50 taught by Eldridge et al.) to a shuttle memory service 202 (i.e. PDA 2 taught by Eldridge et al.).

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Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the method of information transfer taught by Hull in the method for URL document retrieval taught by Eldridge et al. & Iwata. because it would provide a method to forward the URL taught by Iwata to the user of the PDA taught by Eldridge et al.

10. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760) & Srinivasan (US 6 452 689).

Regarding claim 12, Eldridge et al. teach the method according to claim 1, but do not teach the method further comprising a step of conducting a financial clearance.

However, Srinivasan teaches a method further comprising a step of conducting a financial clearance (column 3, lines 48-65, billing system 19 verifies financial clearance and debits the account, i.e. billing ID).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the billing method taught by Srinivasan in the method for document processing and retrieval taught by Eldridge et al. because it allows for billing of the service to the user.

Regarding claim 13, Eldridge et al. teach the method according to claim 1, but do not teach the method further comprising a step of requiring a billing ID from the print client.

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However, Srinivasan teaches a method further comprising a step of requiring a billing ID from the print client (column 3, lines 48-65, billing system 19 verifies financial clearance and debits the account, i.e. billing ID).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the billing method taught by Srinivasan in the method for document processing and retrieval taught by Eldridge et al. because it allows for billing of the service to the user.

11. Claims 14, 16, 23-29, 32 & 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the rejections for claims 1-13 set forth above.

Regarding claims 14, 16, 23-29, 32 & 34-35, Eldridge et al teach the methods taught in claims 1-5, 7-13, but do not explicitly teach that the methods are realized as a computer program product comprising a computer usable medium having computer readable program code embodied in the medium.

However, it is well-known in the art to apply computer program products to methods and it is therefore obvious that the method taught by Eldridge et al. could be implemented in a computer product.

Note: claim 26 is rejected using Eldridge and Petteruti as discussed in claim 7.

12. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760).

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Regarding claim 15, Eldridge et al. teach the print service according to claim 14, wherein the reference is accepted from a direct connection to the print client (fig 1, PDA 2 uses RF of IR to make a direct connection).

13. Claims 17-19 & 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760) & Srinivasan (US 6 452 689).

Regarding claim 17, Eldridge et al. teach the print service according to claim 14, wherein the Internet is used for the print service (column 8, lines 2-52, but they do not teach wherein the print service is a web site allowing the print service to be reached by the print client via the Internet.

However, Srinivasan teaches a print service as a web site allowing the print service to be reached by the print client via the Internet (fig 1, web site 11).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the web print service taught by Srinivasan in the system taught by Eldridge et al. because it provides an effective system for printing document over the internet and it allows for billing of the service to the user.

Regarding claim 18, the claim rejection of claim 17 is representative of claim 18. See Srinivasan teachings wherein the web site is discoverable by the print client through the Internet (fig 1 and column 12, lines 56-62, users discover the web site via the internet).

Regarding claim 19, the claim rejection of claim 18 is representative of claim 19. See Srinivasan teaches wherein the web site is pre-configured into print clients to be

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discoverable when print services are required by the print clients (fig 1, users 10 discover the Web site via the data network 12).

Regarding claim 21, the claim rejection of claim 18 is representative of claim 21. See Eldridge et al. teaches wherein the service is discoverable via network discovery protocols (fig 5, steps s2'-s7').

14. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760) & Srinivasan (US 6 452 689) as applied to claim 18 above, and further in view of Olkkonen et al. (US 6 842 460).

Regarding claim 20, teach the print service according to claim 18, but do not teach a service registry to be discoverable by print clients.

However, Olkkonen et al. teach a discoverable service registry (figs 5, service registry).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the service registry taught by Olkkonen et al. in the web print service taught by Srinivasan & Eldridge et al. because it provides an effective system for registering services for a user near a network

15. Claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760) & Petteruti et al. (US 6 379 058) & W3C (Simple Object Access Protocol (SOAP) 1.1) & Gase (US 6 184 996).

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Regarding claim 30, the claim rejections for claim 27 are represented in claim 30. See Gase wherein the control communications create a new print job (column 3, lines 6-92), check status of an existing print job (fig 2, printer jobs list); and cancel an existing print job (fig 4, printer job detail with CANCEL button 62).

Regarding claim 31, the claim rejections for claim 30 are represented in claim 31. See Gase wherein the print service accepts a request to create a new print job from the print client (column 3, lines 6-9).

16. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760) & Hull (US 6 772 338) & Reece et al. (US 5 915 214).

Regarding claim 33, Eldridge et al. teach the print service according to claim 14. Eldridge et al. do not teach said step of sending any document to the print client.

However, Hull teaches a method (fig 2) wherein information is passed from an office appliance 201 (i.e. the workstation 50 taught by Eldridge et al.) to a shuttle memory service 202 (i.e. PDA 2 taught by Eldridge et al.).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the method of information transfer taught by Hull in the method for document retrieval taught by Eldridge et al. because it would provide a method to forward the document to the user of the PDA taught by Eldridge et al.

Additionally, Eldridge et al. do not teach wherein transcoding is done into a form that depends on a device type of the print client.

However, formatting information for compatibility in mobile devices it taught by Reece et al. (column 7, lines 12-20).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the compatibility formatting function as taught by Reece et al. to send information to clients in the system for retrieving a document and sending it to a client as taught by Eldridge et al. and Hull, because it would assure that the document could be sent to the PDA without compatibility error.

### ***Response to Arguments***

17. Applicant's arguments filed 6/20/2005 have been fully considered but they are not persuasive.

With respect to applicant's argument that Eldridge does not teach print by reference content of a content provider with use of a web based or local print service; has been considered.

Eldridge, column 3, lines 55-58, column 4, lines 1-2 clearly teaches print by reference content of a content provider (the data processing device that is storing the documents) with use of a web based (Internet, column 8, line 5) or local print service.

With respect to applicant's argument that there is no reason to use argument resolution protocol, in particular SOAP with printing by reference; has been considered.

In reply: Protocol is rules set by people such that communication is possible. SOAP is a lightweight protocol for exchange of information in a decentralized distributed environment. The print by reference concept does not requires a particular type of

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protocol to be functioning, and that is the reason why Eldridge does not disclosed any communication rules and regulation. How the electronic signal are being interpreted by the receiving parties are inconsequential to Eldridge invention. Therefore, it would have been obvious to a person with ordinary skill in the art to have modified Eldridge to use any Protocol for communication if the protocol is being used by many users and using that protocol would have allowed Eldridge's invention to be widely used.

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

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19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 28, 2005

A handwritten signature in black ink, appearing to read 'King Y. Poon', is written above the printed name.

**KING Y. POON  
PRIMARY EXAMINER**